

Appl. No. 10/613,220
Reply to Office Action of April 21, 2004

REMARKS/ARGUMENTS

I. Defective Oath or Declaration

Applicants assert that the declaration submitted for this application is not defective. Under the terms of MPEP § 602.05(a), a divisional application may be filed with a copy of the oath or declaration from the prior application. A copy of the oath or declaration from the prior application may be submitted with a divisional application even if the oath or declaration only contains the application number of the prior application. This application is a divisional of prior application Serial No. 09/641,468, which is the application identified in the submitted declaration. Accordingly Applicants assert that the submitted declaration satisfies the requirements of 37 C.F.R. § 1.63.

II. Claim Rejections under 35 U.S.C. § 102(e)

Claims 1-12 and 16-23 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,046,056 ("Parce"). Claim 1 has been amended to overcome this rejection. Since all pending claims ultimately depend from claim 1, and thus include the limitations of claim 1, placing claim 1 in condition for allowance over Parce would place all pending claims in condition for allowance over Parce.

To anticipate a claim under 35 U.S.C. § 102(e), a reference must teach every element of the claim. MPEP § 2131. Accordingly, the Examiner explained her §102(e) rejection by correlating the elements of claim 1 with components of the device disclosed in Figures 4A-4F of Parce. Applicants point out that the same device is shown in Figure 3 of Parce, and Applicants will refer to that figure because it contains a more complete set of reference numbers. The rationale behind the §102(e) rejection appears include the assertion that the "bead resting wells" (326-338 in Figure 3) in Parce correspond to the "component separation region" specified in claim 1. This assertion is supported by the portions of Parce (e.g. col. 17 lines 54-61) that talk about "separating" compounds immobilized on beads from the beads by means of light or a chemical releasing agent. As the text of the pending application makes clear, the type of separation discussed in the application is not the separation of immobilized components from beads. Instead, the pending application states that the type of separation that takes place in the separation channel is the separation of a sample compound into its various components. See e.g.

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paragraph [0044] on pg. 10 of the Application. To differentiate claim 1 from the devices disclosed in Parce, Applicants have specified that the separation region must be filled with gel. This amendment is supported in paragraph [0044] of the Application. Note that even though Parce mentions that the "particle retention zone" (344 in Figure 3) may comprise a gel that holds the particles in place (Parce col. 18 lines 9-14), it doesn't appear that the "particle retention zone" could correspond to the "separation region" specified in claim 1. In summary, Applicants assert that the amended version of claim 1 is not anticipated by Parce, and so claim 1 and all claims dependent from claim 1 should be allowable over Parce.

III. Claim Rejections under 35 U.S.C. § 103(a)

Claims 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parce in view of U.S. Patent No. 5,405,752 ("Nilsson"). Applicant respectfully traverses this rejection because 35 U.S.C. § 103(c) disqualifies Parce from being used as prior art for an obviousness rejection. 35 U.S.C. Section 103(c), effective November 29, 1999, provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c) applies to all applications filed on or after November 29, 1999 including continuing applications (may be continuations, divisionals, or continuations-in-part) filed under 37 CFR 1.53(b). MPEP Section 706.02(k).

The instant application was filed on July 2, 2003 as a continuing application under 37 CFR 1.53(b), so the provisions of 35 U.S.C. § 103(c) apply. Under 35 U.S.C. § 103(c), a reference which qualifies as prior art only under 35 U.S.C. § 102(e) (in addition to §§ 102(f) or (g)) and that is commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). In the present case, the Examiner's § 103(a) rejection primarily relies on the Parce reference, which was filed on December 6, 1996, and which issued on April 4, 2000. Since the present application claims priority to U.S. Provisional Application No. 60/150,293, which was filed on August 26, 1999, the Parce reference only qualifies as prior art under § 102(e) (and/or § 102(f) or (g)). In addition, both the instant application and the Parce reference were commonly owned by the same

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present assignee, Caliper Technologies Corp. (now Caliper Life Sciences, Inc.), at the time the claimed invention of the present application was made. Accordingly, the Parce reference cannot be applied in a rejection under 35 U.S.C. § 103(a) under the provisions of 35 U.S.C. § 103(c). Therefore the obviousness rejection of claims 13-15 based on the combination of Parce and Nilsson is moot.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,




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